The Examiner stated the following in the Office Action:

> Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. Stipulate for the IDS submitted 20 July 2009 the following:
>
> **1) Identify 10-20 patent documents and 10-20 non-patent references considered to be most relevant by Applicants and listed on the IDS submitted 20 July 2009.**
>
> This requirement is deemed necessary because the Examiner has considered the first 20 references and is unable to ascertain the relevance to the current claimed invention. For example, US Patent No. 7,180,342 is directed to a "Frequency doubler circuit with trimmable current control" which is not in the same field of endeavor as the current invention. Due to the high volume of prior art submissions and the lack of readily apparent relevance, the applicant is required to specifically point the examiner's attention to the 10-20 most relevant patent and nonpatent documents.

While Applicant sympathizes with the Examiner's burden with respect to reviewing prior art submitted by Applicant, Applicant believes: 1) this request is not proper under 37 CFR 1.105; and 2) as a result of the *McKesson Information Solutions v. Bridge Medical* (Fed. Cir. 2007) case dealing with inequitable conduct, Applicant must cite the prior art and prosecution documents of related cases, which was done in this case and is the subject of this portion of the Office Action and Response.

Applicant quotes from MPEP 704.11 regarding an explanation of what information may be required (emphasis added):

> **704.11 What Information May Be Required [R-3]**
>
> Information which may be required under 37 CFR 1.105 is that information reasonably necessary to properly examine or treat a matter in a pending or abandoned application filed under 35 U.S.C. 111 (including a reissue application), in a pending or abandoned application that has entered the national stage under 35 U.S.C. 371, in a patent, or in a reexamination proceeding.
>
> There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. **A requirement for information under 37 CFR 1.105 places a substantial burden on the applicant** that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a

requirement under 37 CFR 1.105 may only be made when the examiner has a reasonable basis for requiring information.

The terms "factual" and "facts" are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, **that are sought, and that requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant.** Where the factual information requested related to the subject application, and details thereof, applicant would be expected to make a reasonable inquiry under the circumstances to find the factual information requested (37 CFR 10.18(b)(2)). Applicant need not, however, derive or independently discover a fact, such as by experimentation, in response to a requirement for information. The purpose of 37 CFR 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information.

Thus, to require the Applicant to identify 10-20 of the most relevant references is a substantial burden on the Applicant, and more importantly requires the Applicant to formulate opinions on art cited in related cases. It is respectfully submitted that this request is outside the scope of 37 CFR 1.105 and MPEP 704.11, which clearly states ONLY facts and factual information may be sought and NOT opinions formulated by the Applicant.

Further, as previously mentioned, the *McKesson* case makes it clear Applicant must cite the prior art and prosecution documents of related cases. The CAFC stated in the case that the appropriate test for materiality is "whether a reasonable examiner would have considered the information important, not whether the information would conclusively decide the issue of patentability." Again, such a requirement to narrow down submissions of art from related cases would fly in the face of that test by requiring the Applicant to render an opinion on what a "reasonable examiner" would consider important; a proposition not required (and in fact discouraged) by 37 CFR 1.105 and extremely risky as suggested by current case law. It is also worth noting the prior art cited here is art that was cited, considered, and checked off by another examiner in a related case. It would clearly be a violation of our duty to disclose not to submit the prior art in this case.

In consideration of the remarks above Applicant respectfully requests the Examiner withdraw the request for information under 37 CFR 1.105 and consider the art cited in the IDS submitted July 20, 2009.

Should the Examiner have any questions regarding this response or the application in general, the Examiner is urged to contact the Applicant's attorney, Larry Johnson, by telephone at 408-545-7194. All correspondence should continue to be directed to the address given below.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.18, 1.20 and 1.21 that may be required to maintain pendency of the present application, and to credit any overpayments, to Deposit Account No. 50-3781.

Respectfully Submitted,

Date: March 23, 2010

Larry Johnson
Attorney for Applicant
Registration No. 56,861

Cypress Semiconductor Corporation
198 Champion Court
San Jose, CA 95134
Facsimile: (408) 545-6911
Customer No.: 60909